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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,997	11/20/2000	Robert C. Ross, Jr.	36956-168147	6701

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VENABLE LLP  
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EXAMINER
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NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/714,997	<b>Applicant(s)</b> ROSS, JR., ROBERT C.	
	<b>Examiner</b> George C. Neurauter, Jr.	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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#### **DETAILED ACTION**

Claims 1-9 and 11-20 are currently presented and have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 January 2007 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 16 January 2007 have been fully considered but they are not persuasive.

The Applicant argues that "Outlook 2000" does not teach or suggest a user selectable save message instruction operative, upon a selection by the user of a single user interface element, to automatically store in one of one or more user selected user-assignable personal file folders a user selected previously received message wherein said user selected user-assignable personal file folder is associated with a sender of said previously received message, tagged by one of an email address

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or a username of the sender of said message. The Examiner respectfully disagrees. "Outlook 2000" clearly teaches that a user uses a user interface element to select a save message instruction operative to automatically store a user select previously received message (page 79, specifically "(5) If necessary, in the third box, click the drop-down arrow, and then select Miller Textiles (6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, Done! Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

Therefore, "Outlook 2000" does teach this limitation and the claims as currently presented are not in condition for allowance.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 9, 14, 17, and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by "Microsoft Outlook 2000 Step by Step" ("Outlook 2000").

Regarding claim 9, "Outlook 2000" discloses an electronic message system comprising:

A user selectable save message instruction operative, upon a selection by the user of a single user interface element, to automatically store in one of one or more user selected user-assignable personal folders a user selected previously received message ("existing e-mail message"), wherein said user selected user-assignable personal file folder is associated with a sender of said previously received message, tagged by one of an email address or a username of the sender of said message. (page 78, specifically "(2) In the SBS Practice Inbox Information viewer, click Lee Wong's RE: New Sales Initiative e-mail message."; page 79, specifically "(5) If necessary, in the third box, click the drop-down arrow, and then select Miller Textiles (6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, *Done!* Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

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Regarding claim 14, "Outlook 2000" discloses the system according to claim 9, wherein said user interface element comprises at least one of an icon, a menu selection, and/or a button. (page 79, specifically "(6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes.")

Regarding claim 17, "Outlook 2000" discloses the system according to claim 9, wherein the system is operative to store a plurality of user-selected previously received messages in one of said user-assignable personal file folders associated with said sender of said previously received messages upon a selection by the user of the single user interface element. (page 79, specifically "Next to the Create button, *Done!* Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

Regarding claim 18, "Outlook 2000" discloses a machine-readable medium that provides instructions, which when executed by a computing platform, cause said computing platform to perform operations comprising a method comprising:

receiving, via a selection by the user of a single user interface element, a user selected instruction to store a

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previously received message in a user selected one of one or more user assignable personal file folders associated with a sender of said previously received message, tagged by one of an email address or username of the sender of said message, wherein said instruction comprises at least one of a command and/or a user interface elements and storing in said folder, said message, without the user having to know a location in a file folder hierarchy of said user-assignable personal file folder.

(page 78, specifically "(2) In the SBS Practice Inbox

Information viewer, click Lee Wong's RE: New Sales Initiative e-mail message."; page 79, specifically "(5) If necessary, in the third box, click the drop-down arrow, and then select Miller Textiles (6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, Done! Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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Claims 11, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Outlook 2000".

Regarding claim 11, "Outlook 2000" discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the system is operative to automatically create a new one of said user assignable personal file folders, automatically tagged to at least one of the email address of or the username of the sender of said previously received message when no user assignable personal file folder exists for the sender of said message, however, "Outlook 2000" does disclose creating a new one of said user assignable personal file folders, automatically tagged to at least one of the email address of or the username of the sender of said previously received message when no user assignable personal file folder exists for the sender of said message (page 72, specifically "(2) In the SBS Practice Inbox Information viewer, click the RE" New Sales Initiative e-mail message from Dale Carter..."; page 73, specifically "(5) On the Ways to Organize SBS Practice Inbox panel, click the New Folder button located in the upper-right corner of the screen. The Create New Folder dialog box appears...In the Folder List, a new folder named Miller Textiles appears as a subfolder...In the

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Ways to Organize SBS Practice Inbox panel, Miller Textiles appears in the Move Message Selected Below To box."

It would have been obvious to one of ordinary skill in the art to automatically create providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. See MPEP 2144.04 and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 15 and 19 are also rejected since claims 15 and 19 recite substantially the same limitation as recited in claim 11.

Claims 12, 13, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Outlook 2000" in view of "Sams Teach Yourself Microsoft Outlook 2000 in 24 Hours" ("Teach Yourself").

Regarding claim 12, discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the electronic message system is operative to automatically store in a user-assignable personal file folder associated with the sender of any read receipt report, said report received from the sender of said read receive report in response to a previously sent message, however, "Teach Yourself" does disclose these limitations (page 186, specifically "When you send your message,

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wouldn't it be nice to know when the recipient has read the message? With Outlook you can do this easily. When enabled, Outlook's advanced tracking feature sends you an email message when the recipient opens the mail").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since the references are directed to and disclose using the same electronic message system in order to efficiently send electronic messages, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 13, "Outlook 2000" and "Outlook 98" disclose the system according to claim 12.

"Outlook 2000" does not expressly disclose wherein said read receipt report is a dynamic, active read receipt report comprising a continually updated single file indicating read receipt status indicating which of a plurality of recipients of a previously sent message have and/or have not accessed said previously sent message, and wherein said read receipt report tracks a data and time of access by one of a plurality of

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recipients of said previously sent message, however, "Teach Yourself" does disclose these limitations (page 182, specifically "Click the Cc: button and select another recipient to whom you would like to send a "carbon copy" of the email."; page 186, specifically "When you send your message, wouldn't it be nice to know when the recipient has read the message? With Outlook you can do this easily. When enabled, Outlook's advanced tracking feature sends you an email message when the recipient opens the mail")

Claim 13 is rejected since the motivations regarding the obviousness of claim 12 also apply to claim 13.

Regarding claim 16, "Outlook 2000" discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the system automatically stores a copy of an outgoing message upon being sent to a previously selected one of said user-assignable personal file folders, previously assigned and associated with a recipient of said outgoing message, however, "Teach Yourself" does disclose these limitations (page 225, specifically "A rule is a set of conditions and actions (at least one of each of required) that instructs Outlook how to handle messages."; page 227, specifically Figure 10.6, note "Which type of rule do you want to create?" and "Check messages after sending"; page 228,

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specifically Figure 10.8, note "What do you want me to do with the message?" and "move it to the specified folder" or "move a copy to the specified folder").

Claim 16 is rejected since the motivations regarding the obviousness of claim 12 also apply to claim 16.

Claim 20 is also rejected since claim 20 recites substantially the same limitations as recited in claim 16.

#### ***Allowable Subject Matter***

Claims 1-8 are allowed for the reasons indicated previously.

#### ***Conclusion***

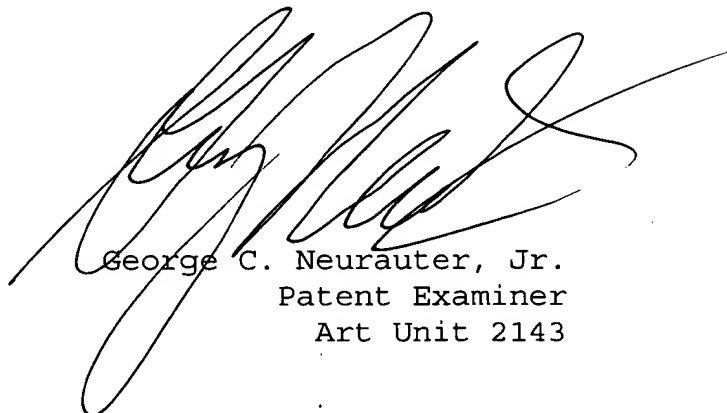
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neuraüter, Jr.  
Patent Examiner  
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